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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/780,679

02/19/2004

Martial Deruelle

022702-049

2008

21839

7590

04/19/2006

BUCHANAN INGERSOLL PC  
(INCLUDING BURNS, DOANE, SWECKER & MATHIS)  
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EXAMINER

PENG, KUO LIANG

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 04/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

CM

<b>Office Action Summary</b>	<b>Application No.</b> 10/780,679	<b>Applicant(s)</b> DERUELLE ET AL	
	<b>Examiner</b> Kuo-Liang Peng	<b>Art Unit</b> 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 3/24/06 Response.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 1-12 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-16, 18 and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Applicant's election with traverse of Claims 13-16 and 18-19 in the response to restriction requirement filed on March 24, 2006 is acknowledged. The traversal is on the ground(s) that a) there is no serious burden on the Examiner; b) It is highly likely that the results of a search of the claims of Group II, which necessarily include all of the features of the composition of Group I. This is not found persuasive because of the following reason: It is noted that as mentioned in the restriction requirement, the composition of Group I can be used in other applications, such as preparing a freestanding film, a molding, or a coating on a substrate other than textile such as concrete, etc. Especially, those dependent claims in Group I need further search. This will clearly cause serious burden on Examiner.

Therefore, Claims 1-12 and 17 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 1712

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 13-16 and 18-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Maruyama (US 5 391 680).

For Claims 13-15 and 18-19, Maruyama discloses a method of coating a textile substrate with a crosslinkable silicone composition. The composition comprises a MDT resin containing hydrolyzable groups and at least one of a silicate (e.g., ethyl silicate, n-propyl orthosilicates, etc.), a polydimethylsiloxane end-capped with hydroxyl groups, amino-containing alkoxysilanes, etc. (col. 1, lines 54-63, col. 2, lines 14-54, col. 7, line 54 to col. 8, line 6 and Examples) Optionally, additives such as solvent, etc can be used. (col. 7, lines 37-48) The composition can be cured as described in col. 8, lines 7-17. For Claim 16, since Maruyama's composition is substantially the same as that of Applicants', Examiner have a reasonable basis to believe that both should impart to the substrates the same properties as set forth in the instant claim. Since PTO does not have proper means to conduct experiments, the burden of proof is now shifted to Applicants to show otherwise. *In re Best*, 195 USPQ 430 (CCPA 1977).

Art Unit: 1712

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/780,679

Page 5

Art Unit: 1712

klp

April 15, 2006

A handwritten signature in black ink, appearing to read 'Kuo-Liang Peng', written in a cursive style.

Kuo-Liang Peng  
Primary Examiner  
Art Unit 1712